

## REMARKS

This is a full and timely response to the outstanding final Office Action mailed January 11, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(e)**

#### **A. Discussion of the Merits of the Rejection**

Claims 1-7 and 9-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Walker, et al. ("Walker," U.S. Pat. No. 6,415,264). Applicant respectfully traverses this rejection.

As was noted in the previous Response, independent claim 1 provides as follows (emphasis added):

1. A method for facilitating sale of a network-enabled device *that is practiced by the network-enabled device*, the method comprising:

*receiving with the network-enabled device* an indication of an intent *to sell the network-enabled device*; and

*automatically transmitting from the network-enabled device* a request to a network-based sales service to post a sale notice that *offers the network-enabled device for sale* on a network.

As is apparent from the above excerpt, Applicant's claim 1 describes a method for facilitating sale of a network-enabled device that is actually practiced by the network-enabled device. Therefore, in accord with Applicant's disclosure, Applicant is claiming a method in which a device facilitates its own sale.

Walker simply does not teach or suggest a method in which a network-enabled device facilitates its own sale. Instead, Walker discloses a “seller device 110” that sends a communication to a network about a *different item* to be sold. Walker, column 3, lines 55-61. Accordingly, Walker does not teach or suggest “receiving with the network-enabled device an indication of an intent to sell the network-enabled device” or “automatically transmitting from the network-enabled device a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on the network”, as are required by claim 1. Claim 1 and its dependent claims are therefore allowable over Walker for at least this reason.

Independent claim 10 provides as follows (emphasis added):

10. A system for facilitating sale of a network-enabled device, the system comprising:

means *provided on the network-enabled device* for receiving indication of an intent *to sell the network-enabled device*; and

means *provided on the network-enabled device* for facilitating transmission of a request to a network-based sales service to post a sale notice that *offers the network-enabled device for sale on a network*.

As noted above in relation to claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. It therefore logically follows that Walker fails to teach or suggest “means provided on the network-enabled device for receiving indication of an intent to sell the network-enabled device” or “means provided on the network-enabled device for facilitating transmission of a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on a network”, as are required by claim 10. Claim 10 and its dependent claims are therefore allowable over Walker for at least this reason.

Independent claim 13 provides as follows (emphasis added):

13. A *device sale manager stored on a computer-readable medium of a network-enabled device*, the manager comprising:

logic configured to receive an indication of an intent to *sell the network-enabled device*; and

logic configured to facilitate transmission of a request to a network-based sales service to post a sale notice that *offers the network-enabled device for sale on a network*.

As noted above in relation to claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. It therefore logically follows that Walker fails to teach or suggest a device sale manager stored on a network-enabled device that includes “logic configured to receive and an indication of an intent to sell the network-enabled device” or “logic configured to facilitate transmission of a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on a network”, as are required by claim 13. Claim 13 and its dependent claims are therefore allowable over Walker for at least this reason.

Independent claim 18 provides as follows (emphasis added):

18. A network-enabled device *that is configured to facilitate sale of itself*, the network-enabled device comprising:

a processing device; and

memory including a device sale manager, the sale manager including logic configured to *receive an indication of an intent to sell the network-enabled device*, and logic configured to *facilitate transmission of a request* to a network-based sales service to post a sale notice *that offers the network-enabled device for sale* on a network.

As noted above in relation to claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. It therefore logically follows that Walker fails to teach or suggest a network-enabled device “that is configured to facilitate sale of itself” and comprises a device sale manager including logic configured to “receive an indication of an intent to sell the network-enabled device” and “facilitate transmission of a request to a network-based sales service to post a sale notice that offers the network-enabled device for sale on a network”, as are required by claim 18. Claim 18 and its dependent claims are therefore allowable over Walker for at least this reason.

Due to the above-described shortcomings of the Walker reference described in the foregoing, Applicant respectfully asserts that Walker does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection be withdrawn.

**B. Reply to Examiner’s “Response to Arguments”**

In the outstanding Office Action, the Examiner states the following in his Response to Arguments:

On page 9, second full paragraph, Applicant’s main argument regarding all pending claims is that Walker does not teach a method in which a network-enabled device facilitates its own sale. More specifically, Applicant alleges that Walker discloses in column 3, lines 55-61 a “seller device 110” that sends a communication to a network about a *different item* to be sold (emphasis by Applicant). Examiner respectfully disagrees. Nowhere does Walker set forth that the seller device 110 send a communication to a network about different item (emphasis added by Examiner). It is the Examiner’s position that the a

user could use a network enabled electronic device (for example a personal computer) to facilitate the sale of said electronic device.

Applicant respectfully asserts that this position is an improper basis for a rejection under 35 U.S.C. § 102(e). As was noted in Applicant's previous Response, "[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, *every* claimed feature of the claimed invention must be taught in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

Irrespective of whether the Examiner believes that a user potentially "could" use a network-enabled electronic device to facilitate sale of itself, the Walker reference provides no teaching on this point. Accordingly, the rejection is *per se* improper and constitutes a reversible error. If Applicant is incorrect about Walker failing to teach using an electronic device to facilitate sale of itself, Applicant requests that the Examiner specifically identify where Walker teaches this action.

## **II. Claim Rejections - 35 U.S.C. § 103(a)**

Claim 8 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Woolston (U.S. Pat. No. 6,085,176). Applicant respectfully traverses this rejection.

As is identified above in reference to independent claim 1, Walker does not teach or suggest a network-enabled device that facilitates its own sale. In that Woolston does not remedy this deficiency of the Walker reference, the rejection fails to teach or suggest all the claim limitations of claim 8.

In view of the above, it is respectfully submitted that claim 8 is patentable over Walker and Woolston and that the rejection should be withdrawn.

Regarding the Examiner's argument that a user potentially "could" use a network-enabled electronic device to facilitate sale of itself, Applicant reiterates that the Walker reference provides no teaching on this point. Applicant again notes that the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching *in the prior art or generally available knowledge of one of ordinary skill in the art* that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows (emphasis added):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either *in the references themselves or in the knowledge generally available to one of ordinary skill in the art*, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, neither reference provides a suggestion or motivation to modify the Walker "seller device" to sell itself. Therefore, the rejection fails to make a *prima facie* case of obviousness.

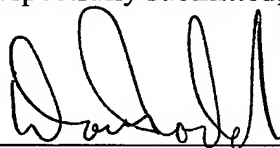
### **III. New Claims**

As identified above, claims 23-37 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

### CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

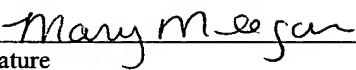
Respectfully submitted,



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